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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,446	01/23/2004	Jennifer Knoepp	MPAK-10003/01	7425

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EXAMINER

CANFIELD, ROBERT

ART UNIT	PAPER NUMBER
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3635

DATE MAILED: 02/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/763,446

Applicant(s)

KNOEPP, JENNIFER

Examiner

Robert J Canfield

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 06/08/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. This is a first Office action on the merits for application serial number 10/763446 filed 01/23/04 as a C-I-P of application serial number 10/635414 filed 08/06/03. Claims 1-21 are pending.

1. The examiner acknowledges receipt of the IDS filed 01/23/04. An initialed copy of the 1449 form is attached.

2. The disclosure is objected to because of the following informalities: the first sentence of the specification incorrectly identifies the parent application as serial number 10/634414 rather than 10/635414.

Appropriate correction is required.

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. Claims 1-20 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-20 of copending Application No. 10/635414. This is a

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provisional double patenting rejection since the conflicting claims have not in fact been patented.

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claim 21 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/635414. Although the conflicting claims are not identical, they are not patentably distinct from each other because each of the elements of the instant claim are included in the co-pending claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-5, 11, 15, 16, 18 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,022,233 to Grundman.

Grundman provides a cover 22 with a handle 46 and a transparent drape 58, long enough to extend to the ground, attached to the cover 22.

9. Claims 1-5, 8, 9, 11, 15-18 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 2,546,228 to Martini.

Martini provides a cover 12 with a handle 14 and a transparent flexible material attached to the cover to enclose a user. The material 18 is provided with fasteners 36 and 37 to close an opening 35.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 6, 7, 12, 13, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,022,233 to Grundman in view of GB 2,222,942 to Yeh.

Yeh teaches that it was known at the time of the invention to provide indicia on both the canopy/cover 14 of an umbrella and on the side panel rain shield 30.

It would have been obvious at the time of the invention to one having ordinary skill in the art that the canopy/cover 22 and drape/shield 56 of Grundman could have been provided with indicia as taught by Yeh. It would have been obvious so as to display a message or design.

12. Claims 6, 7, 12, 13, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 2,546,228 to Martini in view of GB 2,222,942 to Yeh.

Yeh teaches that it was known at the time of the invention to provide indicia on both the canopy/cover 14 of an umbrella and on the side panel rain shield 30.

It would have been obvious at the time of the invention to one having ordinary skill in the art that the canopy/cover 12 and shield 18 of Martini could have been provided with indicia as taught by Yeh. It would have been obvious so as to display a message or design.

13. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 2,546,228 to Martini.

The claim calls for two adjacent covers and protective shields.

It would have been obvious at the time of the invention to one having ordinary skill in the art that two adjacent users using each using a device of Martini could fasten the respective ends of covers 18 to one another to form a single enclosed volume. It would have been obvious such that the users could sit adjacent one another and readily communicate or touch in a single enclosed space.

14. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,022,233 to Grundman.

Grundman provides a cover 22 with a handle 46 and a transparent drape 58, long enough to extend to the ground, attached to the cover 22.

Grundman fails to provide first and second foot covers each enclosing a foot of the user and extending above the end of the suspended flexible material.

The examiner takes Official Notice that it was well known at the time of the invention to one having ordinary skill in the art to wear rain boots during inclement weather. Since the drape of Grundman extends to the ground it would inherently cover the upper edges of rain boots worn by a user during inclement weather.

15. Applicant is advised that should claims 2-7 be found allowable, claims 12, 13, and 15-20 will be objected to under 37 CFR 1.75 as being a substantial duplicates thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). It appears that applicant inadvertently failed to change the dependency of claims 12, 13 and 15-20.

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16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Prior art protective screens having covers, side drapes/shields, indicia and decorative features are listed on the attached PTO 892 form.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert J Canfield whose telephone number is 703-308-2482. The examiner can normally be reached on M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on 703-308-0839. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert J Canfield
Primary Examiner
Art Unit 3635



02/03/05